



DAC/ETW

PATENT PETITION

Attorney Docket No.:

200415-0001-00-US (404536)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent in the name of Michael Conor Minogue, et al. :
Ser. No.:09/902,287 (now US 7,069,089) : US Class: 607/149
Filed: July 10, 2001 :
For: ABDOMINAL BELT WITH ADJUSTABLE ELECTRODES :

RENEWED PETITION TO ACCEPT UNINTENTIONALLY DELAYED

CLAIM OF PRIORITY UNDER 37 CFR 1.78(a)(3)

MAIL STOP PETITION

Office of Petitions
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

Patentees in the above-identified patent hereby petition under 37 C.F.R. § 1.78(a)(3) for acceptance of a priority claim, which was made, but allegedly not perfected in the present patent. The surcharge set forth in 37 C.F.R. § 1.17(t) accompanies this petition. No other fee is believed due. Please charge any fee that is due, and credit any overpayment, to Deposit Account No. 50-0573.

<p align="center">CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)</p> <p>I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Mail Stop Petition, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p>BY <u><i>Katherine H. Plouffe</i></u></p> <p>DATE: <u><i>June 30, 2010</i></u></p>

Statement of Facts

- Patentees filed Irish Application No. S1999/0016 (the "Irish Application") on January 11, 1999.

- Patentees filed PCT/IE00/00004 (the "PCT Application") on January 11, 2000, claiming benefit from the "Irish Application."

- Patentees filed the present application/patent (*i.e.*, US Ser. No. 09/902,287 (now US 7,069,089)) on July 10, 2001. The present application/patent is a continuation of the PCT Application.

- Along with the present application/patent, patentees filed an unsigned declaration that claimed the benefit of priority of the Irish Application and noted that the present application/patent is a continuation of PCT Application. *See Exhibit A of March 4, 2010 Petition.*

- In response to a Notice of Missing Parts, the patentees filed a signed copy of the declaration on October 26, 2001. *See Exhibit B of March 4, 2010 Petition.*

- The PTO acknowledged the claim of priority in an Office Action dated September 12, 2003, where it stated "Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Ireland on Jan 11, 1999. It is noted, however, that applicant has not filed a certified copy of the S990016 application as required by 35 U.S.C. 119(b)." *See Exhibit C of March 4, 2010 Petition.*

- On March 11, 2004, patentees amended the specification of the present application/patent to include a reference to the priority claim. *See Exhibit D of March 4, 2010 Petition.* Specifically, patentees stated "This application is a continuation application of PCT/IE00/00004, filed on January 11, 2000 which claims the benefit of priority to Irish Application No. S1999/0016, filed on January 11, 1999.

- On July 30, 2004, patentees provided the PTO with a certified copy of the Irish Application as an attachment filed on that same date. For the PTO's convenience, Applicants attached to its March 4, 2010 Petition another certified copy of the Irish Application. *See Exhibit H of March 4, 2010 Petition.*

- The PTO "Verified and Acknowledged" the claim of priority in a Bibliographic Data Sheet, which was originally filed along with the present application/patent on July 10, 2001. *See Exhibit E of March 4, 2010 Petition.*

- On May 12, 2006, patentees filed US Ser. No. 11/434,436 ("child application"), which is a divisional of the present application/patent. Patentees stated on the Utility Patent Application Transmittal that the child application is a divisional of the present application/patent. *See Exhibit F of March 4, 2010 Petition.*

- Along with the child application, patentees filed a copy of the declaration from the present application/patent, which claimed that the present application/patent is a continuation of the PCT Application and claims priority to the Irish Application.

- On June 9, 2006, the PTO issued a Filing Receipt in the child application. *See Exhibit G of March 4, 2010 Petition.* Under "Domestic Priority data as claimed by applicant" the PTO stated "This application is a DIV of 09/902,287 07/10/2001 PAT 7,069,089." Under "Foreign Applications" the PTO listed "IRELAND S990016 01/11/1999" and "IRELAND PCT/IE00/00004 01/11/2000."

- On June 4, 2009, patentees filed a Petition Under 37 CFR 1.38(a)(3) To Accept Unintentionally Delayed Claim on Priority Under 37 CFR 1.78(a)(2) And (5) ("First Petition"). In the First Petition, patentees noted, as they do here, that "on July 30, 2004, patentees provided the PTO with a certified copy of the Irish Application."

- On August 3, 2009, the PTO issued a Decision on Petition Under 37 CFR 1.78(a)(3) ("First Decision"), dismissing the First Petition stating that it failed to meet the requirement that "the reference required by 35 U.S.C. §120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted." The Decision also noted that a Certificate of Correction and a Power of Attorney form must be submitted.

- On March 4, 2010, patentees filed a second Petition Under 37 CFR 1.38(a)(3) To Accept Unintentionally Delayed Claim on Priority Under 37 CFR 1.78(a)(2) And (5) ("Second Petition").

- On April 26, 2010, the PTO issued a Decision on Petition Under 37 CFR 1.78(a)(3) ("Second Decision"), dismissing the Second Petition stating that it failed to meet the requirement

that the petition include "the reference required by 35 U.S.C. §120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted." The Second Decision also noted that a Certificate of Correction and a Power of Attorney form must be submitted, noting that (a) the Certificate of Correction mistakenly claimed foreign priority to the PCT application, instead of noting that the present application is a continuation of the PCT, and (b) the Power of Attorney did not include the printed name or the title of the individual signing the document.

Remarks

MPEP 201.11(III)(D) states: "If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt."

Here, patentees, along with the present application/patent, filed a declaration that included a claim to the benefit of priority of the Irish Application and noted that the present application/patent is a continuation of the PCT Application. The Office never issued a filing receipt, but it did recognize the priority claim. In fact, the patent issued with the following text:

"CROSS REFERENCE TO RELATED APPLICATIONS

This application is a continuation application of PCT/IE00/00004,
filed on Jan. 11, 2000 which claims the benefit of priority to Irish
Application No. S1999/0016, filed on Jan. 11, 1999."

Moreover, the Filing Receipt for the child application acknowledges the chain of title going back to the Irish Application.

In other words, patentees included a benefit claim within the time period set forth in 37 CFR 1.78(a), but because no filing receipt was ever issued for the case, patentees are forced to

file this petition. Because the PTO has repeatedly accepted the patentee's claim for priority, and even included it in the issued patent, the granting of this petition should be a mere formality.

Patentees state that the entire delay between the date the claim was due under 37 C.F.R. 1.78(a)(2)(ii) and that date the claim was filed was unintentional.

Conclusion

As summarized below, this Petition meets each of the requirements of 37 C.F.R. 1.78(a)(3):

“(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;” [The patentees previously submitted a certified copy of the Irish Application to the PTO on July 30, 2004 along with an office action response of that same date. A copy of the office action response and another certified copy of the Irish Application were attached as Exhibit H to the March 4, 2010 Petition. A certified copy of the PCT Application was attached as Exhibit I. to the March 4, 2010 Petition]

“(ii) The surcharge set forth in § 1.17(t); and” [A check for the appropriate amount accompanies this Petition.]

“(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.” [See statement above that “Patentees state that the entire delay between the date the claim was due under 37 C.F.R. 1.78(a)(2)(ii) and that date the claim was filed was unintentional.”]

As the Second Decision also requires, the patentees are concurrently filing a corrected Certificate of Correction that indicates the application is a continuation of the PCT application. See *Exhibit 1*. Patentees are also filing a new a Power of Attorney that includes the title and printed name of the person signing the document. See *Exhibit 2*.

Based on the foregoing, patentees respectfully request that its claim to priority to the Irish application be perfected.

200415-0001-00-US (404536)
Renewed Petition to Accept Unintentionally Delayed Claim of Priority
Serial No.: 09/902,287 (now US 7,069,089)

Respectfully submitted,

MICHAEL CONOR MINOGUE, *et al.*

Date: 06-30-10

By: 

ARMANDO A. FLORES

Reg. No. 41,754

Customer No. 23973

DRINKER, BIDDLE & REATH LLP

One Logan Square, Suite 2000

Philadelphia, PA 19103-6996

Tel: (215) 988-2819

Fax: (215) 988-2757